

REMARKS

Introductory Matters

Claims 1-6, 9, 11, and 12 are pending in this application. Claims 1-6, 9, 11, and 12 stand rejected.

The Official Action

Claim Rejections under 35 U.S.C. § 112, second paragraph

First Rejection

Claims 1-8 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner contends that “recitation of ‘or esters, amides, or isosteres of COOH thereof’ in claims 2-3, renders these claims and their dependent claims indefinite.” Applicants traverse.

However, solely to expedite prosecution, applicants have amended claim 1 to recite “R² is CO₂H, CH₂CO₂H, or an ester of CO₂H or CH₂CO₂H selected from C₁₋₁₂aliphatic esters, aryl esters, aralkyl esters, heterocyclyl esters, heterocyclylalkyl esters, C₁₋₁₂aliphatic amides, aryl amides, aralkyl amides, heterocyclyl amides, and heterocyclylalkyl amides; or R² is an isostere of CO₂H or CH₂CO₂H selected from CONHSO₂(alkyl) and CH₂CONHSO₂(alkyl).” Support for this amendment may be found in the specification as originally filed (see e.g., page 11, line 16 to page 12, line 18; see also pages 9-10). Applicants have also amended dependent claims 2-5 to be consistent in scope with amended claim 1. Accordingly, this rejection is obviated.

Because claims 2-6 depend from or refer to claim 1, applicants respectfully submit that the rejection has been obviated for those claims. Applicants also respectfully submit that claims 7-8 were previously canceled. Accordingly, applicants respectfully request that the Examiner withdraw this 112, second paragraph rejection.

Second Rejection

The Examiner contends that claim 5 is improperly dependent as it fails to further limit claim 1 on which it is dependent. Applicants have amended claim 5 into independent format. Accordingly, this rejection is obviated.

Claim Rejections under 35 U.S.C. § 112, first paragraph

Claims 1-6, 9, 11, and 12 stand rejected under 35 U.S.C. § 112, first paragraph because “while being enabling for making salts of the claimed compounds, does not reasonably provide enablement for making esters, amides, and isosteres i.e. prodrugs of the claimed compounds.” Applicants traverse.

However, solely to expedite prosecution, applicants have amended claim 1 to recite “R² is CO₂H, CH₂CO₂H, or an ester of CO₂H or CH₂CO₂H selected from C₁₋₁₂aliphatic esters, aryl esters, aralkyl esters, heterocyclyl esters, heterocyclylalkyl esters, C₁₋₁₂aliphatic amides, aryl amides, aralkyl amides, heterocyclyl amides, or heterocyclylalkyl amides; or R² is an isostere of CO₂H or CH₂CO₂H selected from CONHSO₂(alkyl) or CH₂CONHSO₂(alkyl).” Applicants have also amended dependent claims 2-5 to be consistent in scope with amended claim 1.

In contrast to the Examiner’s contentions, applicants respectfully submit that the instant claims are enabled for making the claimed compounds. Applicants have demonstrated throughout the specification how to make the claimed compounds. Importantly, applicants have disclosed in detail how to make esters falling within the scope of the claims (see, e.g., Methods D and E on pages 34-35; see also Scheme I through Scheme IV on pages 18-21, which shows how to make various tricyclic esters). Accordingly, applicants respectfully submit that the claims are enabled.

The Examiner also contends that it would take “undue experimentation” to determine whether a compound is actually a prodrug or not. Applicants traverse.

First, applicants respectfully submit that the instant claims do not recite “prodrug.” Instead, the claims are directed simply towards “esters, amides, and isosteres” of the tricyclic carboxylic acids. Applicants respectfully submit that the instant claims are enabled. As discussed above, applicants have demonstrated how to make the compounds. Applicants have also demonstrated how to use the compounds. For example, applicants show how to test the compounds (see examples 7-9 on pages 52-54). Applicants also show how to use the compounds as synthetic intermediates in making tricyclic carboxylic acid compounds (see e.g., page 18, line 1 to page 19, line 5). One of skill in the art would be able to make and use the compounds of the instant claims without undue experimentation. Accordingly, applicants respectfully request that the Examiner withdraw this 112, first paragraph rejection.

CONCLUSION

In view of the amendments presented above, applicants believe that pending claims 1-6, 9, 11, and 12 are all in condition for allowance. Accordingly, applicants request that the Examiner enter the above amendments, consider the foregoing remarks, and allow the pending claims to issue. If the Examiner believes that a telephone call would expedite prosecution, the Examiner is invited to contact the undersigned anytime at (617) 444-6525.

Respectfully submitted,

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